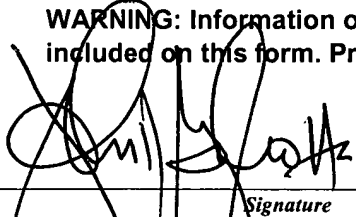



<div style="text-align: right;">IPW/AF</div> <div style="text-align: center;">O I P E AUG 22 2005 PATENT & TRADEMARK OFFICE</div> TRANSMITTAL OF APPEAL BRIEF (Small Entity)					Docket No. 906	
In Re Application Of: John Rolph						
Application No. 10/649,128	Filing Date 08/28/2003	Examiner Tri M. Mai	Customer No. 33055	Group Art Unit 3727	Confirmation No. 4767	
Invention: Combination Torch Snuffer and Cover						
<u>COMMISSIONER FOR PATENTS:</u>						
Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:						
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27						
The fee for filing this Appeal Brief is: \$250.00						
<input checked="" type="checkbox"/> A check in the amount of the fee is enclosed.						
<input type="checkbox"/> The Director has already been authorized to charge fees in this application to a Deposit Account.						
<input checked="" type="checkbox"/> The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 07-2380						
<input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.						
WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.						
 _____ Signature			Dated: August 18, 2005			
John D. Gugliotta, PE, Esq. Reg. No. 36,538 137 S. Main St., Ste. 202 Akron, OH 44308 330-253-5678 330-253-6658 (facsimile)			<div>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on August 18, 2005 (Date)  Signature of Person Mailing Correspondence Terry Lakos Typed or Printed Name of Person Mailing Correspondence</div>			
CC:						



**BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL TO THE BOARD OF APPEALS**

In re Application of: John Rolph)	Date:	August 16, 2005
Serial No.: 10/649,128)	Group Art Unit:	3727
Filed: 11/08/2001)	Examiner:	Mai, T.M.
Title: Combination Torch Snuffer and Cover)		

CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Name:

Terry Lakos
TERRY LAKOS

Date:

8/18/05

BRIEF ON APPEAL

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

This is an appeal from the Final Rejection, dated July 7, 2005 for the above identified application.

REAL PARTY IN INTEREST

The party(ies) named in the caption of this brief are the real parties of interest in this appeal.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to appellant, appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

Currently pending are claims 1-13 which were all finally rejected, which is herein under appeal.

STATEMENT OF AMENDMENTS

There have been no supplemental amendments filed after final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

Referring now to FIG. 1-3 and the specification pages 5, line 2 through page 6, line 18, a cover 10 according to the present invention is shown for use with outdoor patio torches 12 such as to prevent the entrance of rain, dust and other undesirables while the torch 12 is not in use. Designed to enclose the torch 12, wick 14, and wick cap 16, the cover 10 has a generally cylindrical outer housing 20 closed at the upper end by an upper housing cover 22 opposite an entry orifice 24 at the lower end. In order to accommodate the intended use, the internal retention volume 26 formed within the housing 20 is approximately 10" wide and 12" long. Both the upper housing cover 22 and the cylindrical outer housing 20 are formed of light impenetrable material, such

as black vinyl, to protect against ultraviolet light damage.

Formed about the lower circumference of the outer housing 20 near the entry orifice 24 is a circumscribing conduit 30 having a conduit entry 32 through which a drawstring 36 can enter and exit in a manner such as to entirely circumscribe the lower portion of the cylindrical outer housing 20. The internal retention volume 26 formed along the interior of the cover 10 is formed by a flame resistant nylon fiber, such as the fiber NOMEX®. Furthermore, the internal retention volume 26 may be formed by a fabric strengthening nylon fiber, such as the fiber KEVLAR®, to strengthen the fabric to withstand heat and/or manual abuse exerted on the cover 10. Thus, the upper end of the internal retention volume 26 may act to extinguish the torch flame through physical stamping of the flame, while the flame/fire resistant nylon fibers allow the cover 10 to be secured against the top of the torch without fear of burning or severely damaging the cover 10.

In an alternative embodiment, it is anticipated that the drawstring retention means 38 can optionally further comprise an integrally attached extinguishing cap 40. Such an extinguishing cap 40 is anticipated has having a cylindrical cap having a top portion 42 (corresponding to the lower wall of the drawstring retention means), a cylindrical sidewall 44 depending from the top portion 42, and a cavity 46 formed along the interior of the cap 40 by the top portion 42 and the sidewall 44. The cap 40 is placed over a torch flame so that the flame enters the cavity 46 and is enveloped by the top portion 42 and sidewall 44. The cap 40 extinguishes the torch flame by physically stamping the flame along the top portion 42. The cap 40 may then rest on the top surface of the torch until the surface sufficiently cools to receive the cover 10. The cap

40 is manufactured from a fire resistant and durable material, such as metal, stone, glass, plexiglass, acrylic, ceramic, mortar, fire resistant nylon and other similar materials, so that the cap 40 may be used repeatedly without melting, disfiguring or otherwise damaging the cap 40.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The issues on appeal are:

1. Does Claim 8 fail to point out and distinctly claim the subject matter under 35 U.S.C. 112, second paragraph?
2. Are claims 1-3 unpatentable under U.S.C. § 103(a) over Moore et al. in view of Spector?
3. Are claims 9-13 unpatentable under U.S.C. § 103(a) over Moore et al. in view of Spector and further in view of Romero, Jr.?
4. Are claims 1-3 and 9-12 unpatentable under U.S.C. § 103(a) over either Moore et al. or Romero, Jr., in view of Spector?
5. Are claims 4-8 unpatentable under U.S.C. § 103(a) over either Moore et al. or Romero, Jr., in view of Kumasaka?

ARGUMENT

1. Rejections under 35 U.S.C. 113

Claim 8 was rejected under 35 U.S.C. 112, second paragraph, because the examiner was "unclear how the cap can be made from flexible fabric. The

embodiment shown look (sp.) like the cap made from solid rigid material". *Detailed action, page 2, paragraph*. In rejecting a claim under the second paragraph of 35 USC 112, it is incumbent on the examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims. Ex parte Wu, 10 USPQ 2d 2031, 2033 (B.P.A.I. 1989). Further, it is well established that the invention claimed need not be described *ipsis verbis* in order to satisfy the disclosure requirement of §112. ***Ex parte Holt***, 19 USPQ 2d 1211, 1213 (B.P.A.I. 1991)

It is felt by the applicant that the specification, as written, adequately describes and support Claim 8 to one of ordinary skill in the art, and it not limited by the subjective "appearance" of the drawings taken in isolation.

2. Rejections under 35 U.S.C. 103(a)

The examiner respectfully rejected:

1. Claim 1-3 under U.S.C. § 103(a) as being unpatentable over Moore et al. in view of Spector,
2. Claims 9-13 under U.S.C. § 103(a) as being unpatentable over Moore et al. in view of Spector and further in view of Romero, Jr.,
3. Claims 1-3 and 9-12 under U.S.C. § 103(a) as being unpatentable over either Moore et al. or Romero, Jr., in view of Spector,
4. Claims 4-8 under U.S.C. § 103(a) as being unpatentable over either

Moore et al. or Romero, Jr., in view of Kumasaka.

To summarize each of the cited references:

Moore et al discloses a post-guard cover to cover the jagged edges of exposed poses of a vehicle that has had the roof removed.

Spector does not disclose a cover at all, but discloses a play ball in which a flexible casing encloses a toy balloon, and that can convert into a carrying case.

Romero, Jr. et al discloses an exhaust pipe cover.

And, Kumasaka discloses a liquid fuel burning torch itself of the type that the present invention is intended to function as a cover for.

With the possible exception of Kumasaka, there references appear to be nonanalogous art unrelated to the present invention. Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. A reference is reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, . . . [i]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it. In re Clay, 23 USPQ 2d 1058, 1060-61 (Fed. Cir. 1992)

Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there

is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive. ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929, 932, 933 (Fed. Cir. 1984)

Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103, in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103, the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

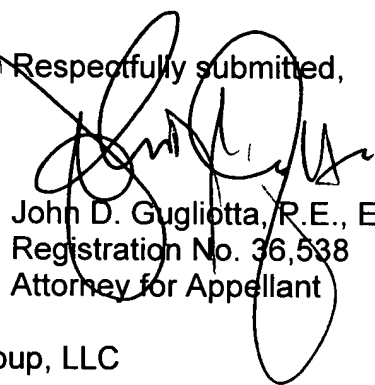
There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed

invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a torch cover having an upper housing with a upper cover at one end, an orifice at an opposite end, having a drawstring, conduit and retention means, and having an internal retention volume adapted to securely fit over a torch and protect the material from which the torch is made from the environmental elements. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Accordingly, the reversal of the Examiner by the honorable Board of Appeals is respectfully solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'John D. Gugliotta', is written over the text 'Respectfully submitted,' and the printed name below.

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CLAIMS APPENDIX

The claims on appeal are as follows:

1. A torch cover comprising:

a generally cylindrical outer housing closed at an upper end by an upper housing cover opposite an entry orifice at a lower end;

a circumscribing conduit formed about a lower circumference of said outer housing near said entry orifice and having a conduit entry;

an internal retention volume formed within said housing of a dimension approximately 10" wide and 12" long;

a drawstring entering and exiting said conduit entry in a manner such as to entirely circumscribe said lower of said cylindrical outer housing; and

drawstring retention means, said drawstring retention means comprising a spring clip, said spring clip for impinging movement of said drawstring.

2. The torch cover of Claim 1, wherein said upper housing cover is formed of light impenetrable material for impeding penetration of damaging UV-A and UV-B sunlight.

3. The torch cover of Claim 1, wherein said cylindrical outer housing is formed of light impenetrable material for impeding penetration of damaging UV-A and UV-B sunlight.

4. A torch cover comprising:

a generally cylindrical outer housing including an upper end and a lower end, said upper end integrally coupled to an upper housing cover, said lower end opposite to said upper end, said lower end forming an entry orifice;

a circumscribing conduit formed about a lower circumference of said outer housing nears said entry orifice and including a conduit entry;

an internal retention volume formed along an interior of said cylindrical outer housing;

a drawstring entering and exiting said conduit entry in a manner so as to entirely circumscribe said lower end of said cylindrical outer housing;

drawstring retention means for mechanically impinging said drawstring; and

an extinguishing cap, said cap integral to said drawstring retention means, said cap comprising a top portion, a cylindrical sidewall depending from said top portion and a cavity formed by said top portion and said sidewall, said cap for extinguishing a torch flame.

5. The torch cover of Claim 4, wherein said internal retention volume measures approximately 10" wide and 12" long.

6. The torch cover of Claim 5, wherein said internal retention volume receives the flame bearing portion of a torch.

7. The torch cover of Claim 6, wherein said drawstring retention means comprises a spring clip.

8. The torch cover of Claim 7, wherein said extinguishing cap is manufactured from a material selected from the group consisting of metal, stone, glass, plexiglass, acrylic, ceramic, mortar and fire resistant fabric.

9. A torch cover comprising:

a generally cylindrical outer housing including an upper end and a lower end, said upper end integrally coupled to an upper housing cover, said lower end opposite to said upper end, said lower end forming an entry orifice;

a circumscribing conduit formed about a lower circumference of said outer housing nears said entry orifice and including a conduit entry;

an internal retention volume formed along an interior of said cylindrical outer housing, said internal retention volume comprising a fire resistant nylon fiber, said fire resistant nylon fiber for preventing fire and heat damage to said cover;

a drawstring entering and exiting said conduit entry in a manner so as to entirely circumscribe said lower end of said cylindrical outer housing; and

drawstring retention means for mechanically impinging said drawstring.

10 The torch cover of Claim 9, wherein said internal retention volume further comprises a fabric strengthening nylon fiber, said fabric strengthening nylon fiber providing structural integrity to said cover so as to allow said cover to withstand repeated use in extinguishing torch flames.

11. The torch cover of Claim 10, wherein said internal retention volume measures

approximately 10" wide and 12" long.

12. The torch of Claim 11, wherein said internal retention volume receives the flame bearing portion of a torch.

13. The torch of Claim 12, wherein said drawstring retention means comprises a spring clip.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None